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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/638,102 | 08/11/2000 | David C. Schwartz | 960296.97133 | 7761 |

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EXAMINER

DAVIS, DEBORAH A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1641

DATE MAILED: 03/18/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/638,102 | SCHWARTZ, DAVID C. | |
| | Examiner | Art Unit | |
| | Deborah A Davis | 1641 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-29-00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, 22 are drawn to a chemical screening apparatus having two different strips of non-reactive substrates and a support frame for receiving and holding strips, classified in class 435, subclass 7.1
 - II. Claims 14-21 are drawn to chemical screening apparatus having one strip of a non-reactive substrate, classified in class 436, subclass 44.
 - III. Claim 23 is drawn to a method of manufacture of strips of a non-reactive substrate comprising a light activating and bonding step, classified in class 427, subclass 2.11.
 - IV. Claims 24-27 are drawn to a method of manufacture of strips of a non-reactive substrate, comprising positioning the strip to have different longitudinal portions positioned in adjacent volumes holding different component solutions, classified in class 427, subclass 213.
 - V. Claims 28-29 are drawn to a method of manufacture of strips of a non-reactive substrate comprising positioning a plurality of strips to pass through a volume bracketing a segment of strips, classified in class 427 subclass 300.
 - VI. Claim 30 is drawn to method of manufacture of strips of a non-reactive substrate comprising placing a mask material over the plane exposing a selected subset of locations, classified in class 427, subclass 445.

- VII. Claim 31 is drawn to a method of manufacture of beads of a non-reactive substrate, classified in class 422, subclass 58.
- VIII. Claim 32 is drawn to a method of screening chemical materials, classified in class 424, subclass 489.
- IX. Claim 33 is drawn to a method of promoting localized chemical reactions, classified in class 436, subclass 518.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions has different modes of operation. The chemical screening apparatus of invention I comprise of two strips and have a support frame for holding the strips. Whereas the chemical apparatus of invention II comprises only one strip and does not require a support frame for its operation.

3. Inventions (III, IV, V, VI) and (I, II) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process claimed can be used to make other products such as kits for testing chlorine and PH levels in swimming pools.

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4. Inventions (VIII, IX) and (I, II) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In the instant case, the apparatuses of inventions I and II can be used to test the PH levels in swimming pools.

5. Inventions (III, IV, V) and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case invention (III, IV, V) and VI has a different mode of operation because they are comprised of different features or steps that are not required by each invention; such as:

- (1) Invention III calls for the use of more than one strip in the light activating and bonding step. Whereas, invention IV call for the use of a single strip in its light activating and bonding step.
- (2) Invention IV also contains the feature positioning the strip to have different longitudinal portions positioned in adjacent volumes holding different components solutions.
- (3) Invention V contains the feature of a volume bracketing a segment of strips.

(4) Invention VI contains a feature of placing a mask material over the plane exposing a selected subset of locations.

6. Inventions VII, VIII, IX are unrelated to all other inventions claimed because the three methods seek different results and they have different modes of operations. For example, invention VII is drawn to a method for manufacturing beads; inventions VIII is drawn to a method of screening chemical materials and invention IX is drawn to a method of promoting localized chemical reactions.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A Davis whose telephone number is (703) 308-4427. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (703) 305-3399. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.



Deborah Davis
Patent Examiner
CMI, 8D08
March 12, 2002



LONG V. LE
SUPERVISORY PATENT EXAMINER
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03/14/02